



IN THE UNITED STATES PATENT
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Technology Center 2100

Merged Proceedings

Reissue Application No.:

09/512,592

United States Patent No.:

5,806,063

Issued: September 8, 1998

Applicant:

Dickens, Bruce M.

Reexamination Proceeding:

90/005,592

Filed: December 21, 1999

Reexamination Proceeding:

90/005,628

Filed: February 2, 2000

Reexamination Proceeding:

90/005,727

Filed: May 16, 2000

Group Art Unit: 2177

Examiner: Jean Homere

Response to Office Action

Box AF

Honorable Commissioner of Patents and Trademarks

Washington, D.C. 20231

Dear Sir:

Responsive to the Final rejection dated April 16, 2003, please amend the above captioned application as follows:

This Merged Proceeding of the above captioned Reexamination Proceedings and Reissue Application relates to the above captioned patent, United States Patent No. 5,806,063, issued to Dickens on September 8, 1998 on an application filed on October 3, 1996, entitled DATE FORMATTING AND SORTING FOR DATES SPANNING THE TURN OF THE CENTURY ("the patent"). A first reexamination was Ordered by the USPTO itself (005,592). A second Reexamination was Ordered in response to a Petition of a first anonymous Requestor (005,628). A third reexamination was Ordered in response to a Petition of a second anonymous Requestor (005,727).

Claims 1-76 were in the above captioned cases. Claims 1-76 have been rejected. Claims 1-76 remain in this case. Claim 54 has been amended, solely for the purpose of correcting a typographical error in the claim, namely that the word "representations" was left out of the claim as filed. For the below stated reasons Applicant respectfully traverses the Examiner's rejections of claims 1-76 and asserts that claims 1-76 should be allowed and respectfully requests that the Examiner allow claims 1-76.

Remarks

1. Applicant has in prior submissions in this merged proceeding fully explained the reasons why the Examiner's rejections of claims 1-76 are improper, and hereby repeats these assertions. Applicant also asserts that the Examiner's complete dismissal of the Declaration of Toreson, without any rebuttal of the assertions made by Mr. Thoreson as an expert in the field, is entirely improper.

2. Applicant has previously explained why the comments of the Examiner in regard to the references cited are improper bases for rejection and are either an incorrect interpretation of the reference(s), a failure to consider the reference(s) as a whole, and/or an incorrect applications of the reference(s) to the express claim language and/or fail to result in a combination that contains all of the claimed elements, and, therefore, fail to support a *prima facie* case of obviousness, and in addition applicants assert that the dismissal of the declaration of Thoreson without the Examiner placing any substantive rebuttal in the record is improper and that the Declaration of Winner adds further support to the arguments made by applicant and ignored by the Examiner. Applicant has also fully explained why the claims distinguish over the portions of the reference(s) cited by the Examiner. Applicant addresses the renewal of the Examiner's §112 rejections below.

3. The Examiner's explanation of the nature of the so-called "Examiner's Rejections" still does not explain why those comments of the Examiner were not in accordance with the requirements of the M.P.E.P. Applicant does not assert that the Examiner must always refer to column and line of a reference, so much as that the M.P.E.P. requires that the Examiner apply the reference to specific claims and portions thereof and the "Examiner's Rejections" did not do this.

4. -25. Applicant has previously explained why the comments of the Examiner in regard to the reference(s) cited are improper bases for rejection and are either an incorrect interpretation of the reference(s), a failure to consider the reference(s) as a whole, and fail to present a combination that contains all of the claim elements, and/or are an incorrect application of the reference(s) to the express claim language, and, therefore, fail to support a *prima facie* case of obviousness, and in addition applicants assert that the dismissal of the declaration of Thoreson without the Examiner placing any substantive rebuttal in the record is improper and that the Declaration of Winner adds further support to the arguments made by applicant and ignored by the Examiner. Applicant has also fully explained why the claims distinguish over the portions of the reference(s) cited by the Examiner. In addition, in each instance where applicant has referred to prior arguments regarding earlier rejected claims in order not to repeat the assertions previously made countering identical base arguments made by the Examiner, applicant has additionally pointed to claim recitations which the examiner ignored and which further distinguish the particular claim(s) over the cited reference(s).

Certain specific errors in the Examiner's continuing arguments represented in these paragraphs include, the Examiner's ignoring the Col. 11, line 3 – Col 18, line 25 explanation of how Shaughnessy actually works in regard to the Examiner's comments in Paragraph 7, and that Applicant does not argue that Ohms is non-analogous art, to the extent that it shows a form of windowing, but, rather that Ohms uses windowing differently and for a different purpose, regarding Paragraph 24.

26. Applicant's objection and point was based on the M.P.E.P. requirement that the Examiner should make all available rejections from the outset of the prosecution, as noted in the prior response, and that the Examiner's failure to do so resulted in months of delay in getting to an appeal of the rejection of this application and indeed now has necessitated the filing of the present RCE and Preliminary Amendment to counter arguments only made in the Final Rejection by the Examiner concerning 35 U.S.C. §112 rejections not made until the second and previous non-Final Office.

27. Applicant submits that the subject matter in the original description, claims and drawings shows that the applicant was in possession of the claimed invention, as would have been understood by one of ordinary skill in the art from such original description, claims and drawing, without the need for undue experimentation, which is the applicable standard. Neither section of the M.P.E.P. cited by the examiner supports the Examiner's contention that a new matter rejection is proper, as opposed to a rejection based upon a lack of enabling disclosure or an inadequate description in the specification and claims as filed being present to support the newly added claims.

28. The accompanying Declaration of Winner, in addition to prior submissions of applicant, support the fact that one skilled in the art, given the disclosure that the invention would facilitate a sort of $C_1C_2Y_1Y_2M_1M_2D_1D_2$ would realize that sorting of just $C_1C_2Y_1Y_2$ is possible, without undue experimentation, if that were needed to demonstrate this inherently clear conclusion.

29. The Examiner takes the position that:

If by definition reformatting dates means modifying or changing the format/representation of dates, how can applicant's claimed imitations [sic, limitations] achieve such reformatting dates without changing date representations.

The answer to this is quite simple, since the very point of the invention is that, while reformatting of the dates occurs in the process of the claimed invention, the dates in the database itself do not get reformatted. Language such as "without modifying any of the symbolic representations of dates in the at least one date field of the database for purposes of such windowing and converting ...", e.g., in claims 60-61 and "without the addition of any new data field to the database for purposes of such windowing and converting ... running a program collectively on the stored converted symbolic representations to sort or otherwise manipulate the dates represented by the converted symbolic representations, separately from the symbolic representations of dates contained in the at least one date field of the database", e.g., in claims 64-65, and "without the addition of any new data field to the database, and without modifying any of the symbolic

representations of dates in the at least one date field, for purposes of such windowing and converting; and, running a program on the converted symbolic representations of each of the dates to sort or otherwise manipulate the dates represented by the converted symbolic representations, separately from the date data symbolic representations contained in the at least one date field of the database”, e.g., in claim 70, make this clear. Claim 33 is reasonably interpreted to mean the same thing.

As to the “without modifying” or “without changing” language, the law is clear, as has been previously cited that the claims do not have to use the precise language of the Specification and the fact these words are not expressly stated in the Specification is not *prima facie* evidence of lack of enablement.

Applicants submit that the Examiner’s belief as to the meaning of these phrases, “not having to add field to store the extra two year digits after date conversion” is exactly the intent of these claims, is supported in the Specifications and claims as filed and in the record of the prosecution of the case as originally prosecuted, and the claims do in fact capture this very “essence.” The enabling nature of the disclosure, claims and drawing as originally filed has been fully discussed by applicant in prior responses. further, Exhibit a additionally supports this meaning of the claims.

30. The Examiner takes the position that, while “pivot date” and “pivot year” may have a well known meaning in the art, the use by applicant of “the cited terms, as claimed, exceeds the scope of their well known meaning in the art.” Applicants submit that the claims 16-30, 32, 34-67, 69-71, 75 and 76 utilized these terms precisely as the art understands them. The Declaration of Toreson supports this as well.

31. The Examiner takes the position that “applicant failed to specifically indicate the specific portions of the cited documents where such limitation is disclosed.” Applicant submits that the Declaration of Toreson and corresponding arguments of counsel sufficiently point out the reasons that the Specification as printed in the Dickens patent alone supports the claims 36-37, 40-41, 51-59, 69 and 38, 39, 42,-43. The

accompanying Declaration of Winner, demonstrates how the disclosure in Exhibit A also supports those claims.

32. Applicant has explained fully how the application as filed and the prosecution history of the issued Dickens patent relate to the Examiner's position here. While not expressly used as a term in the Specification of the Dickens patent as issued, the terminology is supported by the content of the Specification as issued and the record of the prosecution. The addition of the Appendix A disclosure by certificate of correction simply serves to reinforce this disclosure supporting the claim recitations in claims 16-25, 31-33, 66-67, 72 and 36-43. This is more fully explained also in the Declaration of Winner accompanying this response.

33. Applicant has already dealt at length with the support for the claim recitations of claims 36-37, 40-41, 48-49, 51-59, 69 and 38, 39, 42-43. The Declaration of Winner further supports the disclosure contained in Exhibit A supporting such claims.

34. Applicant has already dealt in depth with the issues discussed by the Examiner regarding claims 46-59, and submitted the Declaration of Toreson in this regard, which the Examiner does not contest. The essence of the "without undue experiment" test for enablement by the Specification is that the knowledge of one skilled in the art is used to fill in gaps of the disclosure, necessarily meaning that such gaps exist. The Specification fully and clearly discloses the claimed invention such that it can be practiced without undue experiment, both as printed in the issued Dickens patent and with the content of Appendix A.

35. Applicant has already dealt at length with the issues discussed regarding claims 34-65 and 70-71 employing the term windowing, including the submission of the Declaration of Toreson, which the Examiner does not contest. Windowing is used in the claims at issue in the same way as those skilled in the art understand windowing to mean

in the context of the claimed inventions. The Declaration of Winner is also submitted in this regard.

36. Applicant has already dealt at length with the issues raised by the Examiner regarding claims 35, 37, 49, 43, 45, 51, 53, 55, 57 and 59 concerning the claims recitations regarding "opening the database prior to converting," including submitting the Declaration of Toreson with which the Examiner does not take issue. The Declaration of Winner is submitted to further demonstrate the teaching of Exhibit A in this regard.

37. Applicant agrees that as to claims 34-65, 70 and 71 the meaning of ambiguity as an "inability to discern between two digit dates falling in the 19th and 20th centuries" is supported by the Specification, claims and drawing as filed. Applicant further asserts one skilled in the art would understand that this ambiguity is related to any two centuries overlapping a turn-of-the-century date.

38. Applicant agrees that the claim language in claims 1-15, 31, 33, 68, 72-74 as construed by the Examiner is supported in the Specification, claims and drawing of the Dickens Patent as filed, including as published originally and along with Exhibit A.

39. Applicant agrees with the Examiner's construction of Col. 6, lines 6-22 of Shaughnessy and asserts that the Examiner's construction itself confirms that Shaughnessy selects a 100 year window without concern for the dates of data existing in the database. Applicant concedes that Shaughnessy does suggest selection of a pivot date to determine the end of a 100 year window, but this is not the same as doing so with the earliest date in the database in mind, which Shaughnessy does not suggest.

40. Applicant has dealt at length with the issue of the interpretation of Shaughnessy and Hazama as discussed by the Examiner in this paragraph and simply repeats that the treatment of, e.g., one or two date data fields at a time in a subroutine is

not the claimed conversion of each of the dates in the database to facilitate further processing of all of the dates in the database. It is the Examiner's position that is a non-sequitor, since if correct then any invention using "windowing" to address date ambiguity would be invalid, regardless of whether the claimed invention includes, e.g., other process steps along with the windowing step in the process. Applicant has pointed out numerous other patents employing "windowing" in some fashion or another, including other issued patents besides Shaughnessy. The point is that Shaughnessy and Hazama employ the basic principles of windowing but in other than the claimed processes of the Dickens patent.

41 – 42. Applicant repeats and reasserts the above arguments as well as prior arguments addressing these points.

43 and 45. Applicant submits a new Reissue Declaration.

44. Applicant submits a substitute Specificization.

Conclusions

Applicant submits that claims 1-76 are allowable and respectfully requests that the Examiner withdraw the rejections of claims 1-76 and allow claims 1-76.

Respectfully submitted,

Bruce M. Dickens

Bruce M. Dickens

October 15, 2003

949-857-1487